

REMARKS

Claims 1, 3, 5-9, and 11-29 were pending. The applicants amend claims 1, 3, 12, 18, and 20 and present claims 1, 3, 5-9, and 11-29 for examination in view of the amendments to the following remarks.

Claims 1, 3, 5-9, and 11-29 were rejected under 35 U.S.C. § 112, second paragraph. The applicants request that the rejection of claims 1, 3, 5-9, and 11-19 under 35 U.S.C. § 112 be withdrawn in view of the amendments to claim 1. The applicants note that claim 20 does not recite the phrase "two-dimensionally applied" which the examiner objects to. Accordingly, the applicants request that the rejection of claims 20-29 under 35 U.S.C. § 112 be withdrawn.

Claims 1, 3, 5-9, and 11-19 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Pub. No. 2001/0002605 ("Morawski ") or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morawski . The applicants have amended claim 1 to clarify the claimed structure. Claim 1 recites

a body injection-molded from a first plastic, wherein the body comprises a transparent and/or opaque and/or translucent plastic;

Morawski described a toothbrush body "fabricated from plastic materials by injection molding techniques[.]"¹ However, the applicants are unable to find any indication that the toothbrush body described by Morawski comprises a transparent and/or opaque and/or translucent plastic. Claim 1 also recites

a decoration having a decorative first side and a back side is applied on a surface of the body, with the decorative side of the decoration applied to the surface of the body; and an injection-molded encapsulation of a second plastic covering the decoration

In contrast, Morawski described a decorative pattern on a clear, heat shrinkable plastic film which is applied to a toothbrush body.² For at least these reasons, Morawski does not anticipate independent claim 1 or any of claims 3, 5-9, and 11-19 depending from claim 1.

Moreover, it would not have been obvious to modify Morawski to include the features recited by the applicant's claim 1. Morawski described a decorative plastic layer applied via a

¹ Morawski, paragraph [0040].

² See, e.g., Morawski, paragraph [0046].

heat shrinking process.³ The back side of the decoration is applied to the body with the decorative side facing away from the body of the toothbrush. The applicants apply the decorative side of the decoration to a body so that the decorative side is not damaged during formation of the injection molded encapsulation. Because the body comprises transparent and/or opaque and/or translucent plastic, the decorative side of the decoration is visible through the body. A person of ordinary skill in the art would not have considered modifying the toothbrush described by Morawski because heat shrinking a plastic film doesn't require temperatures as high as injection molding of a plastic encapsulation. Thus, heat shrinking doesn't cause the problem of the features of claim 1 are designed to solve and there would be no reason modify the tooth brush described by Morawski to include these features. In addition, reversing the decoration such that the decorative side of the decoration is applied to the body would keep it from being visible. Thus, Morawski teaches away from the claimed device and therefore does not provide support for the proposed modification.⁴ For at least these reasons, Morawski does not make obvious independent claim 1 or any of claims 3, 5-9, and 11-19 depending from claim 1.

Claims 20-29 were rejected under 35 U.S.C. 103(a) as being unpatentable over Morawski. Claim 20 recites

applying at least a two-dimensional decoration to a surface of the body, the decoration having a decorative front side and a back side, the decoration applied with its decorative front side facing the body, such that the decorative front side is visible through the body; and then

covering the applied decoration with an encapsulating layer of a second plastic, the second plastic injection molded over the decoration;

In contrast, Morawski described positioning a tube of heat-shrinkable plastic film 70 having a decorated pattern about a portion of the handle of the toothbrush body.⁵ Once the tubular film has been positioned on the toothbrush handle, it is then heated to a temperature and for a period

³ See, e.g., Morawski, paragraph [0046].

⁴ *In re Sponnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (If the suggested combination would produce a 'seemingly inoperative device', the references taken in combination can be said to teach away from the invention.) See also *Tec Air, Inc. v. Denso Manfg Michigan, Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (CAFC 1999) and *In re Gordon* (CAFC 1984) (no suggestion to modify a prior art device where the modification would render the device inoperable...).

⁵ See, e.g., Morawski, paragraphs [0053] and [0055].

of time sufficient to cause the film to shrink into conforming contact with the toothbrush handle.⁶

Although the office action asserts that Morawski discloses

applying a decoration on the front and back sides; and then covering the applied decoration with an encapsulating layer of a second plastic, the second plastic injection molded over the decoration;⁷

the applicants are unable to find any indication of these features in Morawski. In particular, Morawski neither describes “applying at least a two-dimensional decoration to a surface of the body ...; and then covering the applied decoration with an encapsulating layer of a second plastic” nor that “the second plastic [is] injection molded over the decoration.” No reason has been advanced as to why the method described by Morawski would be modified to include these features. Thus, the obviousness rejection of claims 20-29 lacks the rational underpinning necessary to support the legal conclusion of obviousness.⁸ For at least these reasons, Morawski does not make obvious independent claim 20 or any of claims 21-29 depending from claim 20.

The applicants submit that the pending claims are in condition for allowance and request notice to that effect. In the event a new office action is issued, the applicants respectfully request that the examiner identify with particularity the features of cited references that are asserted to correspond to the features of the applicants’ claims.

All of the dependent claims are patentable for at least similar reasons as those for the claims on which they depend are patentable.

Canceled claims, if any, have been canceled without prejudice or disclaimer.

Any circumstance in which the applicants have (a) addressed certain comments of the examiner does not mean that the applicants concede other comments of the examiner, (b) made arguments for the patentability of some claims does not mean that there are not other good reasons for patentability of those claims and other claims, or (c) amended or canceled a claim

⁶ See, e.g., Morawski, paragraphs [0053] and [0055].

⁷ Office action dated March 24, 2009, page 4.

⁸ See *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 127 S.Ct. 1727 at 1740 (2007) citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” – emphasis added).

Applicant : Jens Storkel et al
Serial No. : 10/535,436
Filed : September 29, 2005
Page : 10 of 10

Attorney's Docket No.: 02894-0711us1 / 06651-PT22

does not mean that the applicants concede any of the examiner's positions with respect to that claim or other claims.

The fees in the amount of \$130 for the Petition for One-Month Extension of Time fee is being paid concurrently herewith on the Electronic Filing System by way of Deposit Account authorization. Please apply any other charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 02894-0711US1.

Respectfully submitted,

Date: July 24, 2009

/Sean M. Dean/

Sean M. Dean, Ph.D., J.D.
Reg. No. 46,656

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (877) 769-7945

22234417.doc